

NOTED

NOV 11 2008

United States Court of Appeals for the Federal Circuit

2008-1329
(Cancellation No. 92/032,341)

MICHEL FARAH,

Appellant,

v.

PRAMIL S.R.L.,

Appellee.

JUDGMENT

ON APPEAL from the UNITED STATES PATENT AND TRADEMARK OFFICE,
TRADEMARK TRIAL AND APPEAL BOARD

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

AFFIRMED.

ENTERED BY ORDER OF THE COURT

DATED NOV 24 2008

Jan Horbay / S.W.
Jan Horbay, Clerk

ISSUED AS A MANDATE: DEC 15 2008

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UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

By Sam Hall Date: 12/15/08

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NOV 24 2008

U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT

U.S. DEPARTMENT OF COMMERCE

WASHINGTON, D.C. 20540

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

**OPINION ANNOUNCING
JUDGMENT OF THE COURT**

OPINION FILED AND JUDGMENT ENTERED: 11/24/08

The attached opinion announcing the judgment of the court in your case was filed today. The judgment was entered pursuant to Rule 36. The mandate will be issued in due course.

Information is also provided about petitions for rehearing and suggestions for rehearing en banc. The questions and answers are those frequently asked and answered by the Clerk's Office.

Each side shall bear its own costs.

Regarding exhibits and visual aids: Your attention is directed to FRAP 34(g) which states that the clerk may destroy or dispose of the exhibits if counsel does not reclaim them within a reasonable time after the clerk gives notice to remove them. (The Clerk deems a reasonable time to be 15 days from the date the final mandate is issued.)

JAN HORBALY
Clerk

cc: David M. Rogero
Donald L. Dennison

FARAH V PRAMIL SRL, 2008-1329
PTO - TTAB-IP, 92/032341

NOTE: This disposition is nonprecedential.

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David M. Rogero, of Coral Gables, Florida, for appellant.

Appealed from: United States Patent and Trademark Office,
Trademark Trial and Appeal Board.

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United States Court of Appeals for the Federal Circuit

2008-1329
(Cancellation No. 92/032,341)

MICHEL FARAH,

Appellant,

v.

PRAMIL S.R.L.,

Appellee.

Appeal from the United States Patent and Trademark Office, Trademark Trial and Appeal Board.

DECIDED: November 24, 2008

Before MAYER, GAJARSA, and PROST, Circuit Judges.

PER CURIAM.

Appellant Michel Farah ("Farah") appeals a decision by the Trademark Trial and Appeal Board of the United States Patent and Trademark Office ("Board") that canceled Farah's trademark registration No. 2,447,970 in response to a petition filed by Appellee Pramil S.R.L. ("Pramil"). Pramil S.R.L. v. Farah, No. 92032341 (T.T.A.B. Jan. 29, 2008) ("Board Decision"). Because we are not persuaded by Farah's allegations of error, we affirm.

CV-20619 (S.D. Fla. filed Mar. 13, 2006). While Gapardis and IBE later settled, Pramil failed to respond to the complaint, resulting in the entry of a default judgment. The district court permanently enjoined Pramil from using the mark OMIC PLUS and awarded damages to Gapardis.

On June 16, 2007, after completion of the civil proceedings, Farah filed a motion for summary judgment with the Board, alleging that the court's injunction eliminated Pramil's basis for standing and that its judgment collaterally estopped Pramil from asserting the grounds for cancellation. The Board denied this motion on July 26, 2007.

On January 29, 2008, the Board found that Pramil established priority of use and likelihood of confusion and, as a result, granted the cancellation of Farah's registration. Board Decision at 9, 18. Farah appealed the Board's decision, and we have jurisdiction pursuant to 28 U.S.C. § 1295(a)(4)(B).

DISCUSSION

"We apply a limited standard of review to Board decisions, reviewing legal determinations de novo and factual findings for substantial evidence." In re Bose Corp., 476 F.3d 1331, 1334 (Fed. Cir. 2007).

On appeal, Farah argues that the Board erred in various ways. First, Farah alleges that the district court's judgments prevent Pramil from maintaining its cancellation petition because: (1) Pramil lacked standing in the cancellation proceeding once the district court entered the permanent injunction and (2) the district court's default judgment against Pramil collaterally estopped Pramil from asserting the grounds for cancellation. Next, Farah argues that Pramil failed to carry its burden of proof on

In response to Farah's argument that the injunction eliminated Pramil's standing, the Board noted that the injunction does not specifically prohibit Pramil from using its OMIC mark. Rather, the injunction simply orders Pramil not to use the OMIC PLUS mark or "any reproduction, or counterfeit, or copy or colorable imitation" of this mark. Gapardis Health & Beauty, Inc. v. Pramil S.R.L., No. 06-CV-20619 (S.D. Fla. May 23, 2007) (order granting permanent injunction). While that court may later determine that OMIC is a reproduction, counterfeit, copy, or colorable imitation of OMIC PLUS, it has not yet done so. See id. (retaining jurisdiction over enforcement of the injunction). Moreover, contrary to Farah's allegations, the scope of the district court's injunction is not altered by the fact that Pramil alleged (and the Board found) a "likelihood of confusion" between OMIC PLUS and OMIC. Thus, we see no error in the Board's conclusion that Pramil had standing to file the cancellation petition.¹

B

Next, Farah argues that the district court's default judgment against Pramil collaterally estopped Pramil from pursuing the instant cancellation. Like the Board, we are not persuaded by this argument.

"[C]ollateral estoppel may be employed to preclude the relitigation of issues only when those issues were 'actually litigated' in a prior law suit." Lee ex rel. Lee v. United

¹ Farah also briefly argues that its registration of "OMIC" on June 3, 2008, negates Pramil's standing. However, we fail to see—and Farah fails to explain—how a second registration can "negate" a petitioner's standing to challenge a first registration. Specifically, we are not persuaded that this new registration undermines the Board's finding that Pramil has standing due to its "use of the OMIC mark in connection with cosmetics." Board Decision at 3. Moreover, to the degree that Farah attempts to rely on facts underlying this registration (e.g., the asserted date of first use in commerce), Farah should have presented those facts to the Board in the first instance.

associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale,” and (2) “the goods are sold or transported in commerce.” Id. This statute does not require Pramil to make either of the specific showings alleged by Farah.

The Board found that Pramil established its prior use with evidence showing that 6000 units of Pramil’s OMIC product were sold in 1994—six years prior to Farah’s priority date—to a company in Florida. Board Decision at 4-5. Pramil’s witness testified that these products were marked “OMIC.” The Board also noted that the invoice identifies the products with the OMIC mark and that Pramil’s current product packaging clearly displays this mark. Id. at 4-5, 7. Moreover, the Board found “no evidence or testimony” to indicate that Pramil failed to label its products with the mark. Id. at 7. As Farah fails to identify any evidence to the contrary, we conclude that the Board’s factual finding was supported by substantial evidence.

D

Finally, Farah alleges that Pramil failed to prove its continuous use of the mark. Farah asserts that Pramil’s evidence only showed use of the mark from 1994 to 1996 and from 2000 to 2004. Because Pramil allegedly failed to explain the four-year gap between 1996 and 2000, Farah asserts that Pramil failed to carry its burden to establish continuous use of its mark.

As the Board noted, however, abandonment “is a defense to [Pramil’s] evidence of prior use, and therefore [Farah] bears the burden of proof.” Board Decision at 9 (citing W. Fla. Seafood, Inc. v. Jet Rests., Inc., 31 F.3d 1122, 1128-29 (Fed. Cir. 1994)).